I. For Clarity, The Above Claims Have Been Amended

For clarity, Applicant's have amended the above claims to correct minor typographical corrections, and for further clarity of expression of the scope of the invention. The specific changes are set forth in the Appendix attached to this supplemental response.

II. A Terminal Disclaimer is Tendered Under 37 C.F.R. 1.321 Obviates The Obvious Double Patenting Rejection of Claims 183-242

In the Office Action, the examiner rejected under the doctrine of judicially created doctrine of obvious double patenting claims 183-242 over claims 1-10 of U.S. Patent No. 5,965, 631 and over all of the claims of U.S. Patent No. 5,760,100 and its Reexamination Certificate and over all of the claims of U.S. Patent No. 5,776,999 and its Reexamination certificate.

For the express limited purpose to overcome the above double patenting rejection of judicially created doctrine of obvious double patenting, the Applicants hereby submit a terminal disclaimer under 37 C.F.R. 1.321. By using this procedure of a terminal disclaimer submission, Applicant do not admit: that any one of claims 183 -242 are obvious over any the remaining claims 183 - 242, that any of one of the claims of U.S. Patent Nos. 5,595,631, 5,760,100 or 5,776,999 are obvious over any other remaining claims in any of the patents, or that any one of claims 183 -242 of this application are obvious over any one of the claims of any of the above U.S. Patents. See ***Quad Environmental Technologies Corp. v. Union Sanitary District*** 946 F.2d 870, 20 USPQ 2d 1392 (Fed. Cir. 1991) ("[A] terminal disclaimer is of circumscribed availability and effect. It is not an admission of obviousness of the later filed-filed *claimed* invention in light of the earlier-filed *disclosure*, for that is not the basis of the disclaimer."); ***Ortho Pharmaceutical Corp. v. Smith***, 959 F.2d 936, 22 USPQ2d 1119 (Fed. Cir. 1992) ([T]his unitary treatment of the claims with respect to their term of protection does not carry over into an obviousness double patenting attack on the claims after the patent issued.)

III. The Examiner is Requested to Fully Consider The Information in Submitted in The Information Disclosure Regarding On-going Litigation and Foreign Prosecution of the EP Priority Application

For the Examiner's consideration, Applicants have submitted information which may be material to the examination of the present patent application. As indicated in the previous Information Disclosure Statement, the owners of invention of the present patent application are engaged in a patent infringement suit against Bausch & Lomb of Rochester New York, styled *Ciba Vision Corporation et al. v. Baush & Lomb Incorporated,* Civil Action No. 2:99-0034-RWS; United States District Court for Northern District of Georgia, Gainesville Division. During the litigation proceedings, Bausch & Lomb has asserted in a Motion for Summary Judgment, among other assertions, that patents which issued from parent applications of this application are invalid for failure to disclose the best mode under 35 U.S.C. 112, 1st paragraph. In return, Ciba Vision has filed an Opposition to B&L's Motion for Summary Judgment, accompanying by evidentiary submission that support Ciba Vision's Opposition.

In addition, during proceedings before the European Patent Office, Johnson & Johnson Vision Care, Inc. ("Johnson & Johnson") has opposed European Patent No. 0819258 that is based upon an application corresponding to one of the parent patent applications of the present application (on which priority has been claimed). In its opposition, Johnson & Johnson has requested revocation of the patent due to an asserted the lack of novelty under Article 54, among other reasons. In part, the alleged lack of novelty is predicated on U.S. Patent No. 5,260,000, U.S. Patent 5,346,946 and the 510(k) Summary of Bausch & Lomb® Premier 90 (balafilcon A) submission, which prior art was has been submitted to Examiner for consideration in an Information Disclosure Statement. A listing of the prior art relied upon by Johnson & Johnson is at p. 2 of the Opposition. As can best be determined, a number of the asserted references were earlier in the Information Disclosure Statements now before the Examiner. To the knowledge of the undersigned, no ruling has been rendered by the European Patent Office in this Opposition proceeding.

IV. Request for Reconsideration and A Notice of Allowance.

For the above reasons, Applicants request reconsideration of the above rejections double patenting rejection claims 183-242, and issuance of a Notice of Allowance. The indication of the allowance of claims 159 -182 is acknowledged with appreciation. To the extent a further interview will clarify any issues now before the Examiner, the Applicant will be pleased to confer with the Examiner.

Respectfully submitted,

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Appendix A

Mark-up of Amended Claims

192. (Twice Amended). A siloxane hydrogel contact lens having modified surfaces, said hydrogel contact lens comprising a core polymeric material having an oxygen permeability equal to or greater than 69 barrers, said hydrogel contact lens being suited to make contact with ocular tissue and ocular fluids and having a high oxygen permeability and a high ion permeability, said core polymeric material being formed from polymerizable materials comprising:

(a) an oxyperm polymerizable material, , and

(b) an ionoperm polymerizable material,

wherein said lens has a high oxygen permeability and allows ion or water permeation in an amount sufficient to enable the lens to move on the eye such that corneal health is not substantially harmed and wearer comfort is acceptable during a period of continuous contact with ocular tissue and ocular fluids, wherein said lens has an oxygen permeability of at least about 69 barrers and an ion permeability characterized either by an Ionoflux Ion Diffusion Coefficient of greater [grater] than about 6.4 x 10-6 mm^2/sec or an Ionoton Ion Permeability Coefficient of greater than about 0.4 x 10-6 cm^2/min,

wherein said modified surfaces are hydrophilically modified surfaces that are modified by a treatment process selected from the group consisting of coating processes, grafting processes, plasma treating processes, electrical charge treating processes and irradiation processes,

wherein said hydrogel contact lens is adapted for at least 24 hours of continuous wear on a human eye without substantial corneal swelling and without having substantial amounts of lipid adsorption.

223. (Twice Amended). An extended wear contact lens comprising a core polymeric material and upper and lower surfaces, said core polymeric material comprising a silicone copolymer which provides a high ion permeability and a high oxygen permeability; wherein said silicone copolymer comprises an oxyperm polymerizable material selected from the group consisting of siloxane-containing macromers, siloxane-containing monomers, fluorine- containing macromers,

siloxane containing monomers and fluorine-containing monomers, and an ionoperm polymerizable material selected from the group consisting of acrylates, methacrylates, polyalkylene glycols and N-vinyl pyrrolidones, wherein said core polymeric material has at least one continuous [continous] pathway from said upper surface to said lower surface for oxygen transmission [treatment]; wherein said surfaces are hydrophilically modified by a treatment process selected from the group consisting of coating processes, grafting processes, plasma treating processes, electrical charge treating processes and irradiation processes; and wherein said extended wear contact lens can be continuously worn for at least four days on a human eye without substantial corneal swelling.